

### **REMARKS**

The present application was filed on December 8, 2000, with claims 1-42, as a continuation-in-part of U.S. Patent Application Serial No. 09/549,356 filed April 14, 2000, which claims priority to one or more provisional applications filed June 2, 1999. Claims 1-42 remain pending in the present application. Claims 1, 21, 31, 36 and 41 are the independent claims.

Claims 1-8, 11-13, 15-17, 36, 37, 39 and 40 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,828,769 to Burns (hereinafter "Burns").

Claims 9, 10, 14, 18, 31-35 and 38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Burns in view of U.S. Patent No. 5,440,401 to Parulski et al. (hereinafter "Parulski").

Claims 19 and 20 are indicated as containing allowable subject matter.

Claims 21-30, 41 and 42 are allowed.

In this response, Applicants traverse the §102(e) and §103(a) rejections. Applicants respectfully request reconsideration of the present application in view of the remarks below.

The Manual of Patent Examining Procedure (MPEP), Eight Edition, August 2001, §2131, specifies that a given claim is anticipated "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, MPEP §2131 indicates that the cited reference must show the "identical invention . . . in as complete detail as is contained in the . . . claim," citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1 is directed to a method for customizing a digital imaging device for at least one particular user by storing at least one firmware component in a programmable memory of the digital imaging device which controls the operation of the digital imaging device. The method includes the following steps (a) through (c):

(a) providing customization software which can access a plurality of firmware components providing different image appearances, the customization software producing a plurality of images of the same scene having a corresponding plurality of different appearances;

(b) the user selecting one of the plurality of images having a preferred appearance to cause the customization software to access the corresponding firmware component(s); and

(c) providing the selected corresponding firmware component(s) to the digital imaging device and programming the programmable memory of the digital imaging device to store the corresponding firmware component(s) to thereby customize the digital imaging device.

Thus, in the invention as set forth in claim 1, a digital imaging device, such as a digital camera, stores a firmware component that customizes the digital imaging device based on user selection of a corresponding one of a plurality of images.

The Examiner in formulating the §102(e) rejection argues that the claimed digital imaging device is met by the video camera 126 in FIG. 1 of Burns. See the Office Action at page 2, middle paragraph. However, Burns fails to teach or suggest any customization whatsoever of the video camera 126 for a particular user. For example, there is no firmware component that is stored in video camera 126, based on user selection of one of a plurality of images, that serves to customize the video camera 126 for a particular user, in accordance with the above-noted limitations of claim 1. In fact, it appears that the operating parameters of the video camera 126 are not modified in any way in Burns.

Similarly, independent claim 36, which also includes limitations relating to customization of a digital imaging device, is not anticipated by Burns. As indicated above, the video camera 126 of Burns, relied upon by the Examiner as allegedly corresponding to the claimed digital imaging device, is not described as being customized for a particular user in any manner, much less the particular manner set forth in claim 36.

Dependent claims 2-8, 11-13, 15-17, 37, 39 and 40 are believed allowable for at least the reasons identified above with regard to their respective independent claims.


Accordingly, the §102(e) rejection of claims 1-8, 11-13, 15-17, 36, 37, 39 and 40 is believed to be improper, and should be withdrawn.

With regard to the §103(a) rejection over the proposed combination of Burns and Parulski, Applicants initially note that the Examiner again relies on an alleged customization of video camera 126 of Burns. See the Office Action at page 8, last paragraph. As Applicants described above, video camera 126 of Burns is apparently not customized in any manner for a particular user, much less in the particular manner set forth in the claims. The Parulski reference fails to supplement the fundamental deficiency of Burns in this regard. Thus, the collective teachings of Burns and Parulski, even if assumed for purposes of argument to be combinable, fail to meet the limitations of claims 9, 10, 14, 18, 31-35 and 38. The §103(a) rejection is believed to be improper, and should be withdrawn.

It is believed that the claims in the application are allowable over the prior art and such allowance is respectfully requested.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Eastman Kodak Company Deposit Account No. 05-0225.  
*A duplicate copy of this communication is enclosed.*

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